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10/629,392	07/29/2003	Joanne Hunt	84594MSS	6507

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EXAMINER

CAMERON, ERMA C

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/629,392

Applicant(s)

HUNT ET AL.

Examiner

Erma Cameron

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- A) different species of hydrophilic polymer;
- B) generating gas bubbles either before or after coating;
- C) the addition of an acid as in claim 13 or the addition of a compound that releases an acid as in claim 14.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Chris Konkol on September 22, 2004 a provisional election was made WITHOUT traverse to prosecute the invention of PVA as polymer, generating gas bubbles **before** coating and addition of an acid as in claim 13, claims 1, 4-13 and 15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-3 and 14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

However, because the invention of claim 13 has not been disclosed in the prior art, claim 14 has been rejoined into the application and examined.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 4-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1: it is not clear what is meant by “interacting with said solution”. This could have a variety of meanings.

b) Claim 5: it is not clear if the “coating solution” of claim 5 is the same or different from the solution of claim 1.

c) Claim 8 and 10: the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Objections***

6. Claim 7 is objected to because of the following informalities: spelling of “flouro”.  
Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 4, 11 and 15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 765763.

‘763 teaches coating a base material of film or paper with a heat expandable layer of blowing agent and a polymer such as PVA, to make an image forming sheet to be used in inkjet printing, etc (see Abstract, see Claims, 5:29-35, 6:48-7:3). The heat expandable layer 13 of Figure 2 includes both layers 14 and 15 (4:16-26).

9. Claims 1, 6-7 and 11-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ueno et al (5356853).

‘853 teaches making a thermal transfer image receiving sheet with a foamed layer (see Abstract), made from a resin such as an acrylic (16:1-13) and a foaming agent (19:54-68), that

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may also contain a fluoro-surfactant (15:10-28). The foaming may occur with heat either at the time of application of the layer or afterwards (19:42-53).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 765763.

‘763 is applied here for the reasons given above.

‘763 does not disclose that a plurality of layer is simultaneously coated, but this would be a mere variation on the “known coater” practice of ‘763 (3:50-56).

‘763 does not disclose what the ratio of blowing agent to polymer is, but it would have been obvious to one of ordinary skill in the art to have optimized this ratio depending on the type of foam layer desired.

12. Claims 5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueno et al (5356853).

‘853 is applied here for the reasons given above.

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'853 does not teach the % of fluorosurfactant used, but it would have been obvious to one of ordinary skill in the art to have optimized the level of surfactant through no more than routine experimentation depending on the qualities of the foamed layer that are desired.

'853 teaches that the foaming agent can be up to 30 wt % of the resin (12:31-50), which overlaps with applicant's range.

'853 does not disclose that a plurality of layer is simultaneously coated, but this would be a mere variation on known coating practices.

***Allowable Subject Matter***

13. Claims 13 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not disclose nor suggest the method of claim 1 in which the heat is generated by the presence of an acid, and the heat causes the foaming to occur, or the method of claim 1 in which a compound is present that releases an acid upon heating, and the acid reacts with the blowing agent to cause decomposition of the blowing agent and foaming.




***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ERMA CAMERON  
PRIMARY EXAMINER

Erma Cameron  
Primary Examiner  
Art Unit 1762

October 31, 2004